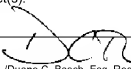


PATENT APPLICATION NUMBER 09/965,071
Attorney Docket Number: 2000-05 (1093 006 301 0202)

PRE-APPEAL BRIEF REQUEST FOR REVIEW		Docket Number 2000-05 (1093 006 301 0202)
	Application Number 09/965,071	Filed Sept. 27, 2001
	First Named Inventor Terrence SICK et al.	
	Art Unit 3693	Examiner S. Chandler
<p>Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.</p> <p>This request is being filed with a Notice of Appeal.</p> <p>The review is requested for the reason(s) stated on the attached sheet(s). Note: No more than five (5) pages may be provided.</p>		
<p>I am the</p> <div style="display: flex; justify-content: space-between;"><div style="width: 45%;"><p><input type="checkbox"/> applicant/inventor.</p><p><input type="checkbox"/> assignee of record of the entire interest. See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed.</p><p><input checked="" type="checkbox"/> attorney or agent of record. Registration number <u>34,545</u></p><p><input type="checkbox"/> attorney or agent acting under 37 CFR 1.34.</p><p><input type="checkbox"/> Registration number if acting under 37 CFR 1.34</p></div><div style="width: 50%; text-align: right;"><p> Signature /Duane C. Basch, Esq. Reg. No. 34,545/</p><p>Typed name <u>Duane C. Basch</u></p><p>Telephone number <u>585-899-3970</u></p><p>Date <u>October 4, 2007</u></p></div></div> <p>NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below w*.</p>		
* Total of _____ forms are submitted.		

This collection of information is required by 35 U.S.C. 132. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11, 1.14 and 41.6. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450

REASONS FOR PRE-APPEAL REVIEW

Rejection of claims 3-6, 8, 9, 11-13 and 15-17 under 35 USC §102(e)

In light of the amendments made to independent claims 3, 11, 16 and 17 in Applicants' response submitted March 15, 2007, Applicants respectfully submit that the limitations therein are not anticipated by Rivette (5,991,751). The §102(e) rejection is respectfully traversed. With regard to the dependent claims, for the sake of brevity, specific discussion of each dependent claim is not set forth herein. Applicants reserve, however, the right to further set forth independent arguments in favor of the patentability of the dependent claims in an Appeal Brief.

"A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). "The identical invention must be shown in as complete detail as is contained in the ... claim." *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989). Thus, as set forth in MPEP §2131, to anticipate a claim, a reference must teach every element recited in the claim. As the following discussion will illustrate, the Examiner has failed to establish as the basis for the rejection, where each recited limitation has been taught by the reference relied upon.

Rivette, cited by Applicants at the time of filing, is directed to a system, method, and computer program product for patent-centric and group-oriented data processing, and discloses a system for evaluating the value of a corporation's patent portfolio. In the "Overview of the Invention" starting at col. 9 (bottom), Rivette describes "evaluating the value of the corporation's patent portfolio (represented as part of the patent information 204)" (col. 10, lines 50-52). Rivette is an example of a system that processes patent information for what is indicated to be a single corporation (*see e.g.*, "a corporate entity" col. 3, line 63; "the corporation" col. 4, line 8). As Applicants have previously urged, Rivette does not appear to disclose or suggest the management of patent (intellectual property) and non-patent (financial) information from multi-company databases by referencing such information to make a decision. Such limitations were previously added wherein reference to both the financial and

intellectual property databases were amended to specifically recite that the respective databases included "data for a plurality of companies."

Instead, Rivette indicates that enterprise server 314 is designed for a customer, where the customer is a "customer corporate entity" (col. 15, lines 50-51), that the data is that which "the customer maintains" (col. 16, line 35) for the company, and as described at col. 17, lines 17-20, the patent database 614 is the "customer's repository of patents." Similarly, at col. 21, line 58 – col. 22, line 6, Rivette characterizes the financial databases 638 as storing financial information pertaining to the customer's business. Hence, the financial database of Rivette is not understood to be one that includes data for a plurality of companies. While Rivette refers to information about competitor companies, it does not appear to contemplate the searching of financial and intellectual property databases having data for a plurality of companies as is presently recited in the amended independent claims, for example, claims 3, 11, 16 and 17.

In the "Response to Argument" (Final Office Action, p. 17), the Examiner first suggests that the limitation of multiple or plural company data in the databases is not claimed, and then states that Rivette discloses the claimed subject matter. The Examiner is believed to be mistaken and to have mis-characterized the teachings of Rivette. First, as noted above, Applicants' prior amendments have added the limitation that information from a plurality of companies is contained in the respective databases as set forth above. Second, although the Examiner urges that such a limitation is taught by Rivette, the Examiner fails to identify support for such teaching, resorting to conjecture ("at a minimum that database would hold ...") to urge that data for other companies would have to be included in the database. The Examiner's reliance on the teaching at col. 10, lines 17-22 is believed to be in error, as there is no suggestion that databases include financial data for a plurality of companies or intellectual property data for a plurality of companies. Absent a specific teaching of the limitations set forth in the claims, Applicants respectfully submit that all limitations of independent amended claims 3, 11, 16 and 17 are not taught and, therefore, cannot be anticipated by Rivette.

Rejection of claim 10 under 35 USC §103(a)

The distinctions over Rivette are generally set forth above relative to claim 3, from which claim 10 indirectly depends. Nonetheless, in response to the Examiner's

submission of "Documentary Evidence," Applicants continue to urge that the rejection of claim 10 is improper and that *prima facie* obviousness has not been established. Accordingly, the rejection is respectfully traversed.

To establish *prima facie* obviousness, three criteria must be met. First, there must be a suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine teachings of references. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). Moreover, as previously urged by Applicants, Official Notice unsupported by documentary evidence should only be taken by the examiner where the facts asserted to be well-known, or to be common knowledge in the art are capable of instant and unquestionable demonstration as being well-known.

Applicants previously urged that the Examiner had not established *prima facie* obviousness as no teaching was identified as suggesting "accessing an assignee/ticker database to determine linkages between the financial database and the intellectual property database on a company basis" as recited in claim 10. The Examiner acknowledges that Rivette did not teach such a step, but urged Official Notice thereof. In response to Applicants' traverse of the Official Notice, for the first time in the Final Office Action, the Examiner now produces what is alleged to be "documentary evidence" to support a position that "it is old and well-known that publicly available financial and intellectual property data concerns assignee and ticker data." Applicants again traverse the Official Notice as not having been demonstrated by the "documentary evidence" where the "documents" provided are search results for an on-line search apparently conducted in April 2007 (well after Applicants filing date of Sept. 27, 2001) for alleged news articles with one or more of various words such as ticker, assignee, etc. Furthermore, none of the articles identified in the search results has been referenced or provided in support of the "Official Notice". The Examiner apparently failed to identify a particular prior art document that indeed teaches that "it is old and well-known that publicly available financial and intellectual property data concerns assignee and ticker data,"

let alone teaches or suggests the recited claim limitation (claim 10) that requires “accessing an assignee/ticker database to determine linkages between the financial database and the intellectual property database on a company basis.” Accordingly, Applicants continue to respectfully traverse the official notice and/or the Examiner’s “documentary evidence” as insufficient to establish any teaching or suggestion of the limitations expressly set forth in claim 10. Absent a teaching of accessing an assignee/ticker database to determine linkages between the financial database and the intellectual property database on a company basis, *prima facie* obviousness cannot be established. Nor has the Examiner established, as required for a rejection under §103(a), a suggestion or motivation to modify or to combine Rivette with the alleged “documentary evidence.” While various sections of Rivette are referred to, none is identified to suggest accessing an assignee/ticker database to determine linkages as alleged by the Examiner. Accordingly, claim 10 is respectfully maintained to be patentable over Rivette.

Rejection of claims 1, 2, 7 and 14 under 35 USC §103(a) traversed

As for amended claim 1, the distinctions over Rivette are generally characterized above relative to similar claims; with respect to claim 1, Applicants respectfully submit that the additional limitations that the databases include data for a plurality of companies are not taught or suggested by Rivette. In the Response to Arguments, the Examiner indicated that the amendment to the preamble has not been given patentable weight. Applicants respectfully submit that the limitation as to the recited database is not a limitation as to purpose or intended use. Rather, the limitation is directed to the structure of the claimed invention (further defining the database) such that “when read in the context of the entire claim, recites limitations of the claim, [and] ... should be construed as if in the balance of the claim.” *Pitney Bowes, Inc. v. Hewlett-Packard Co.*, 182 F.3d 1298, 1305, 51 USPQ2d 1161, 1165-66 (Fed. Cir. 1999).

Moreover, the rejection indicates that the limitation of “relaxing at least some of the search criteria, until at least a required number of matching records are found, wherein the required number of matching records is never less than one” is taught somewhere between columns 25 and 30 (Office Action p. 11 top, and Final Office Action p. 22). Applicants remain unable to identify where such a limitation is taught, and respectfully suggest that the Examiner has failed to establish *prima facie*

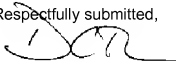
obviousness by identifying support for the alleged teaching (as noted above, the prior art reference or combination must teach or suggest all the claim limitations). This is as much as acknowledged by the Examiner's reliance on an unsupported description of a search methodology set forth in detail at p. 22 rather than a specific reference to Rivette or other prior art. Similarly unpersuasive is the Examiner's new reliance on the terms "iterative" (searching within a prior search result group; col. 26, lines 25-28), "search strategies" ("keyword, keyword phrase, keyword phrases with Boolean, ..."; col. 26, lines 29-33), and "manipulate" ("manipulate and process the search results"; col. 26, line 42), which also fail to suggest relaxation of search criteria. Hence, Applicants continue to traverse the rejection of amended claim 1, and claim 2 dependent therefrom.

As to the rejection of claims 7 and 14, the rejection fails to set forth a basis for teaching of all limitations in the independent claims, and Applicants thereby maintain that the rejection is incomplete on its face. For the sake of brevity, Applicants have not set forth further arguments relative to dependent claims 7 and 14, but reserve the right to submit such arguments in the Appeal Brief in the event that the rejections are maintained.

Conclusion

In view of the foregoing arguments, the Pre-Appeal Brief Conference panel is respectfully requested to reconsider this application, as previously amended, and to indicate an allowance of the claims as amended in the response dated March 15, 2007.

Respectfully submitted,



/Duane C. Basch, Esq. Reg. No. 34,545/

Duane C. Basch

Attorney for Applicant

Registration No. 34,545

Basch & Nickerson LLP

1777 Penfield Road

Penfield, New York 14526

(585) 899-3970